

group I, claims 1-9. The undersigned hereby affirms this election without traverse.

V. REJECTIONS UNDER 35 U.S.C. §103 OVER JP374482 IN VIEW OF FLESHMAN AND BUSHEK

Claims 1, 8, and 9 were rejected under 35 USC §103 as being obvious over Japanese Pat. No. 374482 to Sachibumi Machida in view of US Pat. No. 4,886,471 to Fleshman, and further in view of U.S. Patent No. 6,039,685 to Bushek. The propriety of the rejection of each claim will be addressed individually.

A. Claim 1

1. Obviousness to try and modification or combination of references is not the standard

The Examiner is not only combining references but he is also modifying them without any support for doing so. In order to obtain every element of the claim, the Examiner must modify the Japanese patent application to obtain the female end of the claimed dummy plug. There is no support in any of the three cited references for a dummy plug with a female end, which can receive a male end, as well as replace either a male or female connector. A prima facie case of obviousness is not made out when two references are improperly combined and then modified further to meet the limitations of the claim in issue.

2. All claim limitations must be considered

35 USC §103 requires that the subject matter as a whole be reviewed. There are certain limitations of amended claim 1 which are still not shown in the combination proposed by the Examiner. For example, none of the cited references discloses a female end as recited in

amended claim 1. The Examiner states that, “it would have been an obvious matter of design to provide the dummy plug of JP374482...by modifying the second end of JP 374482 to be a female end for receiving a male pin, since the Applicant does not disclose the reason why the female end needs to have a space to receive the male pin. The female pin does not solve any stated problem or is for any particular purpose.” (Page 4, paragraph 7) However, it can be seen on page 8, lines 26 and 27 of the specification, the female dummy plug is capable of replacing either the male or female connector. A male dummy plug is simply not capable of adequately replacing the female connector, but the female dummy plug is able to replace the female connector, as there is an edge of it that is flush with the latch arm, and is thereby detectable by the pogo pin. Also, none of the references discloses a dummy plug being made of 18 durometer inherently lubricant silicon, as recited in amended claim 1. The Examiner states that Fleshman teaches the plug connector body having about 50–70 durometer in column 8, line 47. However, Fleshman does not disclose any durometer less than 50. Therefore, Fleshman does not disclose 18 durometer inherent lubricating silicon as recited on amended claim 1. According to 35 USC §103, it must be considered and given proper weight if the correct result is to be reached.

3. Prior art does not teach the source of the problem

The Office Action takes the position that it would have been obvious to modify the references, and in particularly the Japanese reference, to include a female dummy plug. However, none of these three references mentions the problem of replacing a female and/or male connector with one single type of dummy plug. The present invention has the advantage of being able to allow manufacture of one type of dummy plug that can be used to replace any type

of connector, whether it is male or female. The prior art clearly does not teach the source of the problem and therefore could not be said to teach its solution.

B. Claims 8 and 9

The arguments made above regarding claim 1 apply equally to claims 8 and 9 and are incorporated herein by reference.

V. REJECTIONS UNDER 35 U.S.C. §103 OVER JP374482

Claims 2-7 were rejected under 35 USC §103 as being obvious over Japanese Pat. No. 374482 to Sachibumi Machida. The propriety of the rejection of each claim will be addressed individually.

A. Claim 2

1. Obviousness to try and modification or combination of references is not the standard

The Examiner is not only combining references but he is also modifying them without any support for doing so. In order to obtain every element of the claim, the Examiner must modify the Japanese patent application to obtain the female end of the claimed dummy plug. There is no support in any of the three cited references for a dummy plug with a female end, which can receive a male end, as well as replace either a male or female connector. A prima facie case of obviousness is not made out when two references are improperly combined and then modified further to meet the limitations of the claim in issue.

2. All claim limitations must be considered

35 USC §103 requires that the subject matter as a whole be reviewed. There are certain limitations of claim 2 which are still not shown in the combination proposed by the Examiner. For example, none of the cited references discloses a female end as recited in claim 2. The Examiner states that, "it would have been an obvious matter of design to provide the dummy plug of JP374482...by modifying the second end of JP 374482 to be a female end for receiving a male pin, since the Applicant does not disclose the reason why the female end needs to have a space to receive the male pin. The female pin does not solve any stated problem or is for any particular purpose." (Page 4, paragraph 7) However, it can be seen on page 8, lines 26 and 27 of the specification, the female dummy plug is capable of replacing either the male or female connector. A male dummy plug is simply not capable of adequately replacing the female connector, but the female dummy plug is able to replace the female connector, as there is an edge of it that is flush with the latch arm, and is thereby detectable by the pogo pin. According to 35 USC §103, it must be considered and given proper weight if the correct result is to be reached.

3. Prior art does not teach the source of the problem

The Office Action takes the position that it would have been obvious to modify the references, and in particularly the Japanese reference, to include a female dummy plug. However, none of these three references mentions the problem of replacing a female and/or male connector with one single type of dummy plug. The present invention has the advantage of being able to allow manufacture of one type of dummy plug that can be used to replace any type of connector, whether it is male or female. The prior art clearly does not teach the source of the

problem and therefore could not be said to teach its solution.

B. Claims 3-7

The arguments made above regarding claim 2 apply equally to claims 3-7 and are incorporated herein by reference.

VI. CONCLUSION


In response to the Office Action dated June 28, 2001, arguments have been provided in response to the Examiner's rejections. At this point, applicant believes that the claims remaining in the case distinguish over the art cited and comply with the requirements of 35 U.S.C. §102, §103, and §112. As such, allowance of the claims is respectfully requested.

The Commissioner is hereby authorized to charge any deficiency in the required fee or to credit any overpayment to Deposit Account No. 05-0875.

Respectfully submitted,

EMERSON & SKERIOTIS

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Date


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